

REMARKS***Status of the Claims***

Claims 1, 3-11, 13-16 and 32-34 are currently pending, with claims 1 and 34 being independent. Applicant notes that in this response no claims are being amended, cancelled, or added. The Listing of Claims is provided for the convenience of the Examiner.

Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding rejections in view of the following remarks.

Claim Rejections Under 35 U.S.C. §§ 102/103

Claims 1, 4, 9, 10, 13, 15, and 16 stand rejected under 35 U.S.C. § 102(b) as allegedly anticipated by or, in the alternative under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 5,017,426 ("Greiser"). Applicant respectfully disagrees with the rejection; therefore, this rejection is respectfully traversed.

Initially, it should be noted that according to M.P.E.P. § 2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

It should also be noted that M.P.E.P. § 2142 provides that "to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, if an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Greiser relates to a laminate, which is suitable as a carrier web for roofing and sealing sheets comprising a preconsolidated synthetic fiber web and a preconsolidated mineral fiber web which are bonded to each other by needling. (Col. 1, lines 47-51). Greiser discloses that preferred mineral fiber webs are glass fiber webs. (Col. 1, lines 66-67). Greiser discloses that two preconsolidated webs are needled to each other and the needling comprises 10 to 100 stitches/cm², preferably between 20 and 50 stitches/cm². (Col. 2, lines 11-14). This needling is carried out in such a way that the needles first enter the synthetic fiber web and then

penetrate through the material fiber web underneath. (Col. 2, lines 14-17). Greiser discloses that the depth of a stitch naturally depends on the thickness of the webs, which is between 6 and 11 mm and leads to a strong positive join of the synthetic fiber web to the mineral fiber web by means of synthetic fibers pulled through the latter. (Col. 2, lines 17-22).

In contrast, independent claim 1 recites wall and floor coverings based on a carrier coated with one or more layers, said carrier consisting essentially of: a fiberglass containing mat pre-consolidated with a binder, and a non-woven mat made of thermally fixed organic synthetic fibers bound with said fiberglass mat by needling, wherein part of said *organic fibers penetrate through said fiberglass mat and lie adjacent to a side of said fiberglass containing mat that is opposite to said organic non-woven mat*; and one or more layers coated on a glass fiber side of said carrier, opposite the non-woven synthetic mat..

The Office Action alleges that it is reasonable to presume that part of the synthetic fibers penetrate through the fiberglass mat and lie adjacent to a side of the fiberglass containing mat that is opposite to the organic nonwoven mat as recited in claim 1, is inherent to the invention of Greiser since it uses a similar needling method to that used to produce the present invention. (Office Action, Page 3).

Applicant respectfully submits that Greiser's disclosure of synthetic fibers pulled *through* the mineral fiber web is not necessarily the same as or equivalent to needling such that a part of the synthetic fibers penetrate the surface of the glass fiber layer and *lie adjacent* thereto. As evidence, the Examiner's attention is respectfully directed to the specification of the present application, wherein it is disclosed that the bond between the coatings and carrier is particularly improved where the synthetic fibers penetrate through the fiberglass mat and are *adjacent* to the underside of the fiberglass mat which is coated on a side away from the non-woven. (Page 8, lines 26-28 and Page 9, lines 1-2).

Greiser does not disclose or suggest that *organic fibers penetrate through said fiberglass mat and lie adjacent to a side of said fiberglass containing mat that is opposite to said organic non-woven mat*, as presently recited in independent claim 1. Moreover, there is no basis to "presume" that Greiser's fibers *lie adjacent* to mineral fiber web merely because the synthetic fibers are "pulled through" the mineral fiber web.

The Examiner's attention is directed to M.P.E.P. § 2112, wherein it is provided that in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent

characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Official Action has provided no reasoning or technical evidence that supports the assertion that it would inherent that Greiser's needling process would necessarily result in synthetic fibers laying *adjacent* to the underside of the fiberglass mat.

According to M.P.E.P. § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill (emphasis added). *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Inherency, however, may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

The rejection set forth in the Office Action is based on the unsupported position that Greiser's needling process would necessarily result in synthetic fibers laying *adjacent* to the underside of the fiberglass mat. In *In re Grasselli*, 218 U.S.P.Q. 769, 775-76 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit considered a prior art rejection under 35 U.S.C. § 103, which the court characterized as having underlying “inferences of inherency.” The court held that the evidence offered to support the rejection did not establish such inherency. Moreover, according to the court in *In re Grasselli*, “if appellant’s catalyst is inherent in the Japanese patent, it has not been established by the record here and obviousness cannot be predicated on that which is unknown”. *Id.* at 776.

Accordingly, Applicant respectfully submits that the inherency position established by the Office is improper for at least the above-noted reasons.

As such, in view of at least the foregoing, Applicant respectfully submits that claims 1, 4, 9, 10, 13, 15, and 16 are not anticipated by, or obvious over, Greiser.

Claim Rejections Under 35 U.S.C. § 103

Claims 5-8, 11, 14, and 33 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Greiser as applied above, and further in view of U.S. Patent No. 5,171,629

("Heidel"). Applicant respectfully disagrees with the rejection; therefore, this rejection is respectfully traversed.

Claims 5-8, 11, 14, and 33 further limit claim 1 by reciting additional features.

As discussed above, Greiser discloses a needling process where the synthetic fibers are pulled through the mineral fibers. (Col. 2, lines 17-22).

Heidel relates to a multi-layered flame resistant carrier web and its production to a bituminized roofing and sealing web containing this carrier web. (Col. 1, lines 7-10). Heidel is cited merely as disclosing additional features to reject claims 5-8, 11, 14, and 33.

As discussed hereinabove, Greiser does not disclose or suggest ***organic fibers penetrate through said fiberglass mat and lie adjacent to a side of said fiberglass containing mat that is opposite to said organic non-woven mat***, as presently recited in independent claim 1.

Heidel is cited merely as disclosing additional features to reject claims 5-8, 11, 14, and 33. Accordingly, as cited, Heidel fails to cure the above-noted deficiencies with respect to Greiser.

Therefore, for at least the above-noted reasons, Applicant respectfully requests that the obviousness rejection of claim over Greiser in view of Heidel be withdrawn.

Claims 3 and 32 stand rejected under 35 U.S.C. § 103(a) as allegedly obvious over Greiser as applied above, and further in view of U.S. Patent No. 5,458,960 ("Nieminem"). Applicant respectfully disagrees with the rejection; therefore, this rejection is respectfully traversed.

As discussed above, Greiser discloses a needling process where the synthetic fibers are pulled through the mineral fibers. (Col. 2, lines 17-22).

Nieminem relates to a flexible base web for a construction covering, comprising, a main layer extending at least over the greatest part of the thickness of the web and being constituted of a non-woven mineral fiber mat containing predominantly discontinuous mineral fibers, said mat containing further blend fibers, the mat being manufactures using a dry method by means of air stream. (Col. 1, lines 4-10). Nieminem is cited merely as disclosing additional features to reject claims 3 and 32.

As discussed hereinabove, Greiser does not disclose or suggest ***organic fibers penetrate through said fiberglass mat and lie adjacent to a side of said fiberglass***

containing mat that is opposite to said organic non-woven mat, as presently recited in independent claim 1.

Nieminem is cited merely as disclosing additional features to reject claims 3 and 32. Accordingly, as cited, Nieminem fails to cure the above-noted deficiencies with respect to Greiser.

Therefore, for at least the above-noted reasons, Applicant respectfully requests that the obviousness rejection of claim over Greiser in view of Nieminem be withdrawn.

Claim 34 stands rejected under 35 U.S.C. § 103(a) as allegedly obvious over Greiser in view of Heidel as applied above, and further in view of U.S. Patent No. 4,569,088 ("Frankenburg"). Applicant respectfully disagrees with the rejection; therefore, this rejection is respectfully traversed.

As discussed above, Greiser relates to a laminate, which is suitable as a carrier web for roofing and sealing sheets comprising a preconsolidated synthetic fiber web and a preconsolidated mineral fiber web which are bonded to each other by needling. (Col. 1, lines 47-51). Greiser discloses that preferred mineral fiber webs are glass fiber webs. (Col. 1, lines 66-67). Greiser discloses that two preconsolidated webs are needled to each other and the needling comprises 10 to 100 stitches/cm², preferably between 20 and 50 stitches/cm². (Col. 2, lines 11-14). This needling is carried out in such a way that the needles first enter the synthetic fiber web and then penetrate through the mineral fiber web underneath. (Col. 2, lines 14-17). Greiser discloses that the depth of a stitch naturally depends on the thickness of the webs, which is between 6 and 11 mm and leads to a strong positive join of the synthetic fiber web to the mineral fiber web by means of synthetic fibers pulled through the latter. (Col. 2, lines 17-22).

Heidel relates to a multi-layered flame resistant carrier web and its production to a bituminized roofing and sealing web containing this carrier web. (Col. 1, lines 7-10).

Frankenburg relates to protective garments for foundry workers comprised of a continuous poly(tetrafluoroethylene) fiber surface and a substrate fabric of non-fusible textile fibers. (Col. 1, lines 5-8).

In contrast, independent claim 34 recites wall and floor coverings comprising a carrier coated with one or more layers, said carrier consisting essentially of: a glass fiber-containing mat pre-consolidated with a binder; and a non-woven mat comprised of thermally fixed

organic synthetic fibers bonded to said fiberglass mat by hydrodynamic needling, wherein part of said *organic fibers penetrate through said glass fiber mat and lie adjacent to a side of said glass fiber-containing mat that is opposite to said organic fiber non-woven*; and at least one layer bonded to a glass fiber side of said carrier, opposite the non-woven synthetic mat.

Applicant respectfully submits that Greiser's disclosure of synthetic fibers pulled *through* the mineral fiber web is not necessarily the same as or equivalent to needling such that a part of the synthetic fibers penetrate the surface of the glass fiber layer and *lie adjacent* thereto. As evidence, the Examiner's attention is respectfully directed to page 7, lines 1-9, wherein it is provided that hydrodynamic needling is performed at a water beam pressure of preferably about 200 to 400 bar. As such, the bond between the coatings and carrier is particularly improved where the synthetic fibers penetrate through the fiberglass mat and are *adjacent* to the underside of the fiberglass mat which is coated on a side away from the non-woven. (Page 8, lines 26-28 and Page 9, lines 1-2).

Greiser does not disclose or suggest a hydrodynamic needling process which is performed at a water beam pressure of about 200 to 400 bar. As such, Greiser's needling process is not the same as or equivalent to the needling process used to obtain the carrier presently recited. Moreover, Greiser does not disclose or suggest that *organic fibers penetrate through said fiberglass mat and lie adjacent to a side of said fiberglass containing mat that is opposite to said organic non-woven mat*, as presently recited in independent claim 1.

Moreover, the Examiner's attention is directed to M.P.E.P. § 2112, wherein it is provided that in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Official Action has provided no reasoning or technical evidence that supports the assertion that it would inherent that Greiser's needling process would necessarily result in synthetic fibers laying *adjacent* to the underside of the fiberglass mat.

According to M.P.E.P. § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993);

In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill (emphasis added). *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Inherency, however, may not be established by probabilities or possibilities. *Id.* The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Id.*

The rejection set forth in the Office Action is based on the unsupported position that Greiser's needling process would necessarily result in synthetic fibers laying *adjacent* to the underside of the fiberglass mat. In *In re Grasselli*, 218 U.S.P.Q. 769, 775-76 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit considered a prior art rejection under 35 U.S.C. § 103, which the court characterized as having underlying "inferences of inherency." The court held that the evidence offered to support the rejection did not establish such inherency. Moreover, according to the court in *In re Grasselli*, "if appellant's catalyst is inherent in the Japanese patent, it has not been established by the record here and obviousness cannot be predicated on that which is unknown". *Id.* at 776.

Accordingly, Applicant respectfully submits that the inherency position established by the Office is improper for at least the above-noted reasons.

In view of at least the foregoing, Applicant respectfully submits that claim 34 is not obvious over Greiser in view of Heidel and further in view of Frankenburg.

Conclusion

For the reasons noted above, the art of record does not disclose or suggest the inventive concept of the present invention as defined by the claims.

In view of the foregoing remarks, reconsideration of the claims and allowance of the subject application is earnestly solicited. In the event that there are any questions relating to this application, it would be appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution of this application may be expedited.

Respectfully submitted,

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